

In this regard, the parent application recites features in the claims pertaining to determining link traversals leading to a page (see, e.g., claims 22 and 40) and further recites claims pertaining to the charging of clients for individual access to links (see, e.g., claim 30) or to track purchases (see, e.g., claim 6). The claims also recite features such as user demand (see, e.g., claim 37), access patterns (see, e.g., claim 36), and relationships between customer demographics (see, e.g., claim 39), each of which are parts of “marketing feedback” discussed in the parent specification (see col. 4, lines 37-42). It cannot be said that “charging for advertising on the web” and “measuring the effectiveness of advertising” are not substantially embraced by these features. While these features are not explicitly disclosed, it is clear that they are inherently a part of the subject matter being claimed. Accordingly, Applicants submit that a supplemental oath or declaration is not required.

37 C.F.R. §1.131 Affidavit/Declaration

The Office Action again states that the evidence submitted in the 1.131 affidavit is insufficient to establish a reduction to practice of the invention prior to the effective date of the *Catledge* and *Novick* references (see below). No further details are provided by the Office Action, with the exception of the reference to the Interview Summary mailed on September 2, 2004. In the summary, no additional detail is provided, other than the affidavit “could be considered” by the Examiner. Applicants maintain that the 1.131 Affidavit is sufficient to overcome the *Catledge* and *Novick* references, and if the Examiner continues to hold the position that the affidavit is insufficient to establish a reduction to practice, that the Examiner clearly state the reasons for any alleged deficiencies.

Claim Rejections – 35 U.S.C. §112

Claims 1,4-6 and 9-11 were rejected under 35 U.S.C. §112 as containing subject matter which was not described in the specification in a way sufficient to enable one of ordinary skill in the art to make or use the invention. Applicants respectfully traverse this rejection.

Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. For terms that are not well-known in the art, or for terms that could have more than

one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action. *See Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64, 31 USPQ2d 1161, 1167-68 (Fed. Cir. 1994) (MPEP 2164.04).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (MPEP 2164.04).

The Office Actions to date have repeated this rejection, with a conclusory statement asserting that the disclosure recites “suggestions” that do not equate to enablement. However, there has been no evidence presented as to why someone of ordinary skill in the art would not be able to make and use the claimed invention without undue experimentation. The analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP § 2164.01(a) and the evidence as a whole. Furthermore, according to the MPEP. The analysis should focus on the aforementioned factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. (MPEP 2164.04). The Examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. See MPEP § 2164.06(a). References should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). However, specific technical reasons are always required. To date, no technical reasons have been provided.

Furthermore, paragraph 5 of the §112 rejection baldly asserts that “charging for advertising on the web” and “measuring the effectiveness of advertising” is presumed to be within the skill of the art. Not only are these statements incorrect, they directly undermine the rationale for aforementioned 35 U.S.C. §112(1) rejection. The Applicants cannot effectively reply to Office Actions when positions taken in those Actions maintain simultaneously divergent arguments to the subject matter. Claim features cannot be “not enabled” and “obvious” at the same time. Accordingly, Applicants request that the 35 U.S.C. §112(1) rejection be withdrawn.

Claim Rejections – 35 U.S.C. §102

Claims 1 and 3 were rejected under 35 U.S.C. §102(a) as being anticipated by *Gary Welz*, “The Media Business on the WWW: The Price and Value of Advertising on the WWW” (hereafter “*Welz*”). Applicants respectfully traverse this rejection.

The *Welz* publication is pursuant to the *Electronic Proceedings of the Second World Wide Web Conference '94: Mosaic and the Web*. While the proceedings are identified as having taken place in 1994, the Conference Tracks indicates that “[t]his should be considered a work in progress until shortly after the Conference when the last of the papers are submitted and the final corrections are made” (see <http://archive.ncsa.uiuc.edu/SDG/IT94/Proceedings>) There is no indication how long after the Conference papers were being submitted, from what sources the papers were obtained from, and how long it took for them to publish the documents. In fact, the electronic file contains no indication of a publication date or retrieval date. Under MPEP 2128, if the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. §102(a) or (b). Accordingly, *Welz* cannot be considered prior art for the purposes of the rejection until a definitive publication date or retrieval date is established. Until such time, Applicants submit that the §102 rejection is improper and should be withdrawn.

Claim Rejections – 35 U.S.C. §103

Claims 2, 4-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Welz* in view of *Wecker* (US Patent 5,806,077). Claims 6-12 were rejected under 35 U.S.C. §103(a) as

being unpatentable over *Wecker* (US Patent 5,806,077) in view of *Welz*. Applicants respectfully traverse this rejection.

In light of the arguments provided above, *Welz* is not prior art with respect to the present application. Accordingly, the §103 rejection is improper and should be withdrawn.

Claims 1-12 were alternately rejected under 35 U.S.C. §103 as being unpatentable over *Lara D. Catledge et al.*, "Characterizing Browsing Strategies in the World Wide Web" (*Catledge*) in view of *Bob Novick*, "The Click Stream" (*Novick*). The Applicants traverse these rejections. Favorable reconsideration is respectfully requested.

As mentioned above, an affidavit was previously submitted by George Winfield Treese, one of the inventors named in the present application. In the affidavit Mr. Treese, declared that the invention described and claimed in the present invention was conceived and reduced to practice prior to March 20, 1995. Thus, even if the combined teaching of *Catledge* and *Novick* taught or suggested the invention claimed in the present application, the articles were not published in this or a foreign country before the date of invention by the Applicant. Accordingly, *Catledge* and *Novick* may not be considered prior art for purposes of 35 U.S.C. §103(a) against the present application. Therefore, all of the pending claims are allowable over the art of record.

In light of the above remarks, Applicant respectfully submits that the claims as presently amended are all in condition for allowance. Applicant therefore requests that the Examiner allow the claims move the application to issue. However, if there are any remaining issues the Examiner is encouraged to call Applicants' attorney, Peter Zura at (312) 807-4208 in order to facilitate a speedy disposition of the present case. If any additional fees are required in connection with this response they may be charged to deposit account no. 02-1818.

Respectfully submitted,

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